



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/876,942

06/08/2001

Charles A. Porter

28310-8005.US

9076

25096 7590 01/23/2009

PERKINS COIE LLP

PATENT-SEA

P.O. BOX 1247

SEATTLE, WA 98111-1247

EXAMINER

BASHORE, WILLIAM L

ART UNIT

PAPER NUMBER

2175

MAIL DATE

DELIVERY MODE

01/23/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* CHARLES A. PORTER, ARAM CHRISTIAN ABAJIAN,  
KEN ALAN BERKUN, AUSTIN DAVID DAHL,  
JOHN ANTHONY DEROSA, ERIC CARL REHM,  
SRINIVASAN SUDANAGUNTA, JONATHAN ROBERT NOWITZ,  
ROBIN ANDREW ALEXANDER, and SCOTT CHAO-CHUEH LEE

---

Appeal 2008-3074  
Application 09/876,942  
Technology Center 2100

---

Mailed: January 23, 2009

---

Before DALE M. SHAW, *Chief Appeals Administrator*  
SHAW, *Chief Appeals Administrator*.

ORDER REMANDING APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on April 26, 2008. A Docketing Notice was mailed and Appeal No. 2008-3074 was assigned on May 1, 2008. A review of the application has revealed that the application was not ready for an appeal. Accordingly, the Telephonic hearing scheduled for 10:00 am on

January 22, 2009, has been canceled and the application is herewith being remanded to the Examiner. The matter requiring attention is identified below.

A review of the IFW application reveals that on February 13, 2008, Appellants filed an Amendment along with a Reply Brief. However, the record does not indicate that the Examiner has considered the amendment filed on February 13, 2008.

It is noted that 37 C.F.R. § 41.39(2)(b) states that if a new ground of rejection has been made Appellant(s) must exercise one of the following two options:

(2) An examiner's answer may include a new ground of rejection.

(b) If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) *Reopen prosecution*. Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under *ex parte* reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as set forth in § 41.41. Such a reply brief must address each new ground of rejection as set forth in § 41.37(c)(1)(vii) and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

Since Appellants filed an Amendment with the Reply Brief the Reply Brief must be treated as a request to reopen prosecution. This case is remanded to the Examiner to have prosecution reopened.

Accordingly, it is ORDERED that the application is remanded to the Examiner:

- 1) to reopen prosecution in view of the Amendment filed February 13, 2008; and
- 2) for such further action as may be appropriate.

If there are any questions pertaining to this order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

DMS/pgc

PERKINS COIE LLP  
PATENT-SEA  
P.O. BOX 1247  
SEATTLE WA 98111-1247